

rejected out of hand, with no evidence provided by the Examiner where their limitations can be found in any prior art.

Even if the references did show all of the claim limitations, the Examiner has provided no explanation as to why someone of ordinary skill in the art would have combined Miyazaki et al. (U.S. Patent No. 6,441,863) with Heigl et al. (U.S. Patent No. 5,122,878), which was filed in 1989. Heigl et al. teaches video tuning using coils and capacitors, which were abandoned years ago, by those of ordinary skill. Figures 1, 2 and 3 of Heigl et al. and the text of the specification clearly shows the use of reactive components (coils and capacitors) to tune a video tuner. When the instant application was filed ten years later in 1999, no one of ordinary skill in the art would have even considered the teachings of a reference showing coils and capacitors as Heigl et al. does.

The Examiner appears to rely on some sort of motivation to combine Heigl et al. and Miyazaki et al. to reduce circuit size using Heigl et al. Of the several “objects” recited in the Summary of Heigl et al., one object stated in line 22-27 of column 2 is reducing circuit size.

When the instant application was filed in 1999 however, reducing circuit size would not have been considered possible using inductors (e.g., coils 30, 31, 32 in Fig. 2 of Heigl et al.) Such an object of Heigl et al. would have easily been achieved by 1999 state-of-the art digital technology, well known in 1999. The Examiner’s argument that someone would have been motivated to combine Heigl et al. and Miyazaki et al. to reduce circuit size is baseless. Using what Heigl et al. teaches would actually yield larger tuners than would 1999 state-of-the-art technology. Heigl et al., was filed in 1989. Coils and capacitors fell out of favor years ago for several reasons, including cost, size, stability, accuracy, etc., all of which are well-known to those of ordinary skill in the electronics art.

The Examiner presumably knows that the Federal Circuit has repeatedly held that showing obviousness by combining references requires some teaching, motivation or suggestion to combine the references. Teaching, motivation or suggestion to combine references can come from the references themselves or in other prior art. The Examiner has not shown any reason why anyone of ordinary skill in the art would combine Miyazaki et al. (U.S. Patent No. 6,441,863) with a reference that was filed in 1989 and which teaches technology that fell out of favor years ago. Indeed, the analog circuitry of Heigl et al. might not be fast enough or accurate enough to accomplish the claimed function of tuning to a first frequency, obtaining a first video frame, tuning to a second frequency and obtaining the next video frame.

While the Office Action provides no justification for combining Miyazaki et al. and Heigl et al., the references do not even show all of the pending claim limitations. In particular, claim 1 that requires that a single tuner, capture the first field of video on a first frequency and that the same tuner captures a second field of video at a second frequency. The two video fields or frames are claimed to be adjacent in time. Where is this limitation in either Miyazaki et al. or Heigl et al? Can the Examiner show that the circuitry of Heigl et al. would be capable of such operation? Where is there any teaching in the cited references any teaching that satisfies the limitation of claim 1 that requires the reception of successive video frames on two different frequencies by the same tuner?

The rejection under 35 U.S.C. §103(a) is improper unless the Examiner can show by column and line number where each of the limitations of claim 1 can be located in the prior art references, but equally importantly, a showing, teaching, motivation or suggestion to combine the references selected by the Examiner.

The Examiner appears to be predisposed to reject the claims without finding any reference upon which the claim rejections are based.

As for claim 2, in paragraph 2, on page 3, the Examiner admits that Miyazaki et al. and Heigl et al. do not teach the limitations of pending claim 2, but without any evidence whatsoever, the Examiner summarily determined claim 2 to be invalid. According to the Examiner, the subject matter claimed in claim 2 is allegedly known to those of skill in the art.

If the Examiner's position regarding claim 2 (and the other dependent claims) is correct, why is it that he has not provided a single reference showing the limitations of claim 2? That he has not shown even a single reference is an admission that he apparently cannot. If the Examiner contends that the subject matter of claim 2 is well known, it is incumbent upon him prove it by showing such a reference and some motivation to combine multiple references, or withdraw the rejection.

Paraphrased, claim 3 recites a step of providing a second frequency indicator to the video tuner prior to the step of tuning the video tuner to a second frequency. As he did with claim 2, the Examiner summarily rejected claim 3 without identifying any reference that shows the claimed subject matter. Unless the Examiner can find a reference or references that show all of the limitations of claim 3, and some motivation to combine multiple references, the rejection of claim 3 should be withdrawn.

With respect to claim 4, the Examiner also rejected claim 4 out of hand, contending without any evidentiary support, that Miyazaki and Heigl "inherently teach a method" that includes the step of providing the second frequency indicator in 1.2 milliseconds or less. The applicant again demands that the Examiner substantiate his position by identifying a reference that teaches the limitations of claim 4 or withdraw the rejection.

Paraphrased, claim 5 requires that every other frame of a signal be displayed alternatingly with the every other frame of a second signal. For claim 5, the Examiner contends (incorrectly again) that Miyazaki and Heigl show the claim limitations but fails to justify the rejection. Claim 5 depends on claim 1 and for that reason alone it is allowable for the reasons set forth above. In addition however claim 5 recites that the single video tuner is tuned to the first frequency after receiving the second field. A third field is then received, on the first frequency and the third field is displayed. The references cited by the Examiner simply do not teach the limitations of claim 5.

Claim 6 was rejected ostensibly because Miyazaki teaches the subject matter claimed therein. The Examiner cited column 15, lines 3-42 of the Miyazaki et al. reference. Claim 6 depends on claim 1 and for that reason alone is allowable over the prior art. The Examiner has not located where each and every limitation of claim 1 is found in the references nor has the Examiner substantiated why anyone would combine the Heigl et al. and Miyazaki et al. references.

Notwithstanding the impropriety of the rejection under 103(a), claim 6 requires that the first and second fields of claim 1 are adjacent video fields when no video is transmitted on the second frequency. Paraphrased, claim 6 requires that video frames of a single frequency be shown when no other frames are available on the second frequency. Such an alternate method of operation is not shown or suggested in column 15, lines 3-42 of Miyazaki et al. This passage of Miyazaki teaches a method of resizing a video image, which would be performed in a picture-in-picture video display. The applicant is nonplussed by the Examiner's reliance upon column 15, lines 3-42.

Claim 7 has been cancelled without prejudice.

As for claim 8, paraphrased it requires a single video tuner to be tuned to a first frequency, receive a first video frame then tuned to a second frequency and receive a second video frame from a second source. The first and second video frames are required to be adjacent

in time. The tuner then returns to the first frequency and receives a third video frame. In a full motion video sequence but which are both comprised of alternating video frames.

The applicant objects to the rejection of claim 8 for the reasons set forth above with respect to claim 1. The Examiner has failed to show where the two cited references teach the reception of successive video frames from two different video sources in such a way that a first video signal provides a first frame and the next frame is obtained from a second video signal in an alternating sequence such that every other video frame of both signals are displayed simultaneously.

Neither Heigl et al. nor Miyazaki et al. teach any circuitry or methodology by which the method of claim 8 could be performed. Moreover, the Examiner has provided no motivation in either of the two references or the prior art to combine them and allegedly come up with the claim limitations.

With respect to claim 9, the Examiner contends that Heigl et al. and Miyazaki et al. combined disclose the method of displaying a video and alternating the reception of first and second video frames at a common tuner. The applicant renews its objection to this claim rejection and demands that the Examiner show by column and line number where the circuitry of either Miyazaki et al. or Heigl et al. show or suggest the alternating reception of video frames.

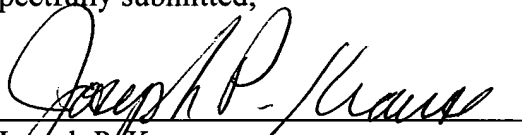
Claim 10 was also rejected by the Examiner without justification or with factual support.

Claims 11 and 12 were also improperly rejected for the reasons set forth above.

Unless the Examiner can identify by column and line number where each and every limitation of the pending claims is located, the rejection under 35 U.S.C. §103(a) based upon Heigl et al. and Miyazaki et al. is improper. Even if the limitations are somehow located in these two references, the Examiner is required to show the motivation, teaching or suggestion to combine Heigl et al. and Miyazaki et al. to achieve the claimed result.

The rejection was improper and should be withdrawn.

Respectfully submitted,

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